

## **REMARKS**

In the Office Action, the Examiner withdrew claims 18 and 21-26 as directed to a non-elected invention; rejected claim 19 under 35 U.S.C. § 112, first paragraph; and rejected claims 1, 9, 17, 19, and 20 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,404,393 to Remillard ("*Remillard '393*") in view of U.S. Patent No. 5,404,393 to Bull et al. ("*Bull*"). *Remillard '393* incorporates U.S. Patent Application No. 07/770,520 to Remillard (now U.S. Patent No. 5,396,546) by reference ("*Remillard '546*").

By this amendment, Applicants amend claims 1, 9, 17, and 20, and add new claims 27-34.

### **I. The Withdrawal of Claims 18 and 21-26**

The Office Action alleges that claims 18 and 21-26 are "independent or distinct" because claims 1 and 9 are "directed to tracking viewer tendencies ... based upon [a] single viewer" while claims 18 and 21-25 "are directed towards ... tracking tendencies of a group of individuals." (Office Action at p. 2). The Office Action is incorrect. MPEP § 802.01 states that the term "independent" means the inventions are "unconnected in design, operation, and effect," and the term "distinct" means the inventions "*as claimed* are not connected in at least one of design, operation, or effect" (emphasis in original).

However, claim 1 recites a method comprising "reorganizing a first electronic television program guide into a second electronic television programming guide tailored to the first viewer, the reorganizing being done in accordance with the first viewer tendency information." Claim 18 recites, in full:

storing personal information for the first viewer; and

grouping the first viewer with a group of viewers and storing group viewing tendency information for the group, the group of viewers being determined based on the personal information for the first viewer, wherein the organizing of the first electronic program guide tailors the second electronic programming guide to the viewer based at least partly on group viewing tendency information.

(emphasis added). Thus, claim 18 is connected to claim 1 in operation, because claim 18 states that the reorganizing step of claim 1 includes "tailor[ing] the second electronic programming guide to the viewer based at least partly on group viewing tendency information." Because claim 18 is connected to claim 18 in operation, claim 18 is not "independent and distinct" from claim 1.

For the reasons discussed above, the restriction of claim 18 is improper. Claims 21-26 depend from claim 18, and the restriction of these dependent claims is improper for at least the reasons discussed above with respect to claim 18.

## **II. The Rejection of Claim 19 under 35 U.S.C. § 112, first paragraph**

The Office Action alleges that claim 19 lacks support in the specification (Office Action at p. 3). Claim 19 recites, in full:

the server operational expenses collecting method according to claim 1, wherein the second electronic programming guide includes a group of programs that the first viewer absolutely wishes to view.

The Office Action states that "the specification does not disclose how one might determine what the first viewer absolutely wishes to view and how a group of programs meeting such a requirement can be obtained" (Office Action at p. 3). However, Applicants' specification states:

database 13 stores the broadcasting dates of programs which the user wants to view without failure at organizing virtual channels, their broadcast times, and their titles. Let the programs which the user wants to view without failure be an absolute viewing program group ...

(emphasis added)(specification at p. 43). Claim 19 is fully supported by at least this portion of the specification.

As claim 19 is fully supported by the specification, Applicants respectfully request the Examiner to withdraw the rejection of claim 19 under 35 U.S.C. §112, first paragraph.

**III. The Rejection of Claims 1, 9, 17, 19, and 20 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 1, 9, 17, 19, and 20 under 35 U.S.C. § 103(a).

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See id. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1996) . . . The factual inquiry . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1, for example, recites a server operational expenses collecting method. The method comprises, among other things, "reorganizing a first electronic television program guide into a second electronic television programming guide tailored to the first viewer, the reorganizing being done in accordance with the first viewer tendency information."

*Remillard '393* discloses "[a]n electronic device and method for accessing remote electronic facilities and displaying associated information on a conventional television set," and programming information can be downloaded to the electronic device (*Remillard '393*, abstract). *Remillard '393* also discloses monitoring television selection information to monitor programs watched by a user to create a user profile, and using

"configuration information" to identify particular services desired by the user to include in a menu (*Remillard '393*, col. 2, lines 44-58).

The Office Action alleges that *Remillard '393* discloses "that these profiles are used to determine user preferences ... [and are] accessed when the system auto configures the menus available to the user" (Office Action at p. 6). This is incorrect. *Remillard '393* does not state that the user profiles have any bearing on the configuration information used to create the menus. *Remillard '393* merely states that the user profile is uploaded to "an appropriate facility through by use of the telecommunications medium" (*Remillard*, col. 2, lines 60-62). Therefore, *Remillard '393* does not teach or suggest "reorganizing a first electronic television program guide into a second electronic television programming guide tailored to the first viewer, the reorganizing being done in accordance with the first viewer tendency information" as recited by independent claim 1.

*Remillard '546* discloses a card reader that permits a viewer to purchase pay-per-view programming (*Remillard '546*, col. 3, lines 20-25). The Office Action appears to rely on this disclosure of *Remillard '546* in stating that "[a] menu listing options from which a user can select pay-per-view programming to view is a programming guide" (Office Action at p. 7). Even assuming this is correct, *Remillard '546* does not disclose that the pay-per-view programming appears as a menu option. Further, even assuming that pay-per-view programming were to appear in some capacity on one of *Remillard '546*'s menus, *Remillard '546* does not disclose reorganizing pay-per-view programming into such a menu. At best, the proposed combination might be read to disclose configuring a menu to allow a user to pay for programming using the card reader.

Therefore, *Remillard '546* does not teach or suggest "reorganizing a first electronic television program guide into a second electronic television programming guide tailored to the first viewer, the reorganizing being done in accordance with the first viewer tendency information" as recited by independent claim 1.

*Bull* fails to cure the deficiencies of *Remillard '546* and *Remillard '393*. *Bull* discloses an information aggregation and synthesization system and process (*Bull*, abstract). However, *Bull* does not disclose reorganizing television program guides. Therefore, *Bull* fails to teach or suggest "reorganizing a first electronic television program guide into a second electronic television programming guide tailored to the first viewer, the reorganizing being done in accordance with the first viewer tendency information" as recited by independent claim 1.

Although of different scope, independent claim 9 is distinguishable over *Remillard '546*, *Remillard '393*, and *Bull* for at least the same reasons as claim 1. Because the cited references fail to teach or suggest each and every element recited by claims 1 and 9, no prima facie case of obviousness has been established with respect to these claims. Applicants therefore request the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

The dependent claims recite additional features not taught by the cited references. For example, claim 20 recites a "server operational expenses collecting method according to claim 1, wherein the second electronic programming guide organizes programs into virtual channels, each virtual channel including programs from a plurality of program channel frequency bands" (emphasis added). The Office Action relies on *Remillard '393*'s menu configuration in addressing claim 20 (Office Action at p.

6). However, *Remillard '393* does not disclose grouping programs from different frequencies. Therefore, *Remillard '393* does not teach or suggest a "second electronic programming guide organizes programs into virtual channels, each virtual channel including programs from a plurality of program channel frequency bands" (emphasis added), as recited by independent claim 20. *Remillard '546* and *Bull* fail to cure these deficiencies of *Remillard '393*.

#### **IV. Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: October 6, 2008

By: /David W. Hill/  
David W. Hill  
Reg. No. 28,220